

Appl. No. 10/633,807
Amdt. dated August 15, 2005
Reply to Office Action of June 7, 2005

8894.01-1

REMARKS/ARGUMENTS

Claims 1 – 4 and 10 – 20 remain in this application. Claim 17 has been amended to correct a typographical error. Claims 5 – 9 are withdrawn from consideration as directed to non-elected species. Claims 21 – 50 are withdrawn from consideration as directed to a non-elected invention.

Reconsideration and reexamination is respectfully requested.

Claims 1 – 4, 10 – 12 and 14 – 17 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent Number 5,709,620 (Reinprecht) and applicant's admission of the prior art. The rejection is respectfully traversed.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §2142. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP §2143.03.

Regarding claims 1, 2, 4, 10 – 12 and 14 – 17 the Examiner stated that "it would have been obvious to one of ordinary skill in the art to place a person at a location where a typical player might stand during that shot to better simulate actual game situations. The persons placed at these locations can be considered simulated opponents for practice purposes." Applicant respectfully submits that nothing in applicant's description of the prior art or in Reinprecht

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discloses or suggests "selectively directing one or more opponents to appear at one or more locations on said playing surface to train said player to strike game objects away from an opponent" as set forth in claim 1, or "wherein said step of directing said one or more opponents to appear comprises operating one or more simulated opponents to simulate the play of one or more players having a selected skill level" as set forth in claims 2 and 14. Similarly, applicant respectfully submits that nothing in applicant's description of the prior art or in Reinprecht discloses or suggests "selectively directing one or more opponents to appear at one or more locations on the opposite side of said tennis court to train said tennis player to return tennis balls away from an opponent thereby teaching said tennis player to play the tennis court and training placement memory in the brain of said tennis player in addition to training muscle memory by returning said tennis balls" as set forth in claim 10. Further, applicant respectfully submits that nothing in applicant's description of the prior art or in Reinprecht discloses or suggests "wherein the step of operating said one or more simulated opponents comprises operating one or more simulated opponents to simulate one or two tennis players moving to a plurality of locations on the opposite side of the tennis court" (claim 15); "said step of operating said one or more simulated opponents comprises operating selected ones of said simulated opponents to cause an opponent to selectively appear as said one or more of said locations" (claim 16); or "said step of operating said one or more simulated opponents comprises operating selected ones of said simulated opponents to move said one or more simulated opponents to selectively appear at one or more of a plurality of locations on the opposite side of the tennis court" (claim 17).

The third criteria required to establish a *prima facie* case of obviousness is not met since Reinprecht taken alone or in combination with applicant's disclosure of the prior art simply does not disclose or suggest all the elements of claims 1, 2, 4, 10 – 12 and 14 – 17 as discussed above. Applicant respectfully submits that applicant's description of the prior art, "For example, tennis players often train by returning balls projected by a ball machine or hit by a trainer to their side of a tennis court to develop their ball return skills." (paragraph [0001]) and "When a trainer is used to hit tennis balls to the side of the tennis court occupied by the player being trained there can be a tendency for the player being trained to hit the ball back to the trainer so that a volley can be sustained." (paragraph [0021]) does not disclose or suggest the method claimed in claims 1, 2, 4, 10 – 12 and 14 – 17 as pointed out above. Likewise, applicant respectfully submits that

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Reinprecht is directed to "... a sport court training assemblage of targets for assisting in striking or throwing a ball or object to a specific location ..." (column 3, lines 31 – 33), and "... develop the skill of striking or throwing a ball or other object to a specific location; ..." (column 5, line 1) does not disclose or suggest the method claimed in claims 1, 2, 4, 10 – 12 and 14 – 17 as pointed out above.

Thus, applicant respectfully submits that the rejection of claims 1, 2, 4, 10 – 12 and 14 – 17 as unpatentable over Reinprecht and applicant's admission of the prior art fails to satisfy the third criteria required to establish *prima facie* obviousness, namely that "all the claim limitations must be taught or suggested by the prior art": *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP §2143.03. Accordingly, applicant respectfully submits that the rejection of claims 1, 2, 4, 10 – 12 and 14 – 17 is defective for failing to establish *prima facie* obviousness of the rejected claims in view of the cited prior art and should be withdrawn.

Regarding claims 3 and 13 the Examiner stated "tennis ball machines are old and well-known in the art to sequentially project balls to players". Applicant respectfully submits that the rejection of claims 3 and 13 is defective for failing to establish *prima facie* obviousness for the same reasons as set forth above with respect to claims 1 and 10 on which claims 3 and 13 respectively depend. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1956 (Fed. Cir. 1988)." MPEP §2143.03

The Examiner has acknowledged that claims 18 – 20 are directed to allowable subject matter.

Upon allowance of generic claims 1 – 4 applicant respectfully requests that non-elected species claims 5 – 9 be considered and allowed.

In view of the Examiner's earlier restriction requirement, applicant retains the right to present claims 21 – 50 is a divisional application.

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For the reasons presented above, it is believed that the application, as now presented, is in condition for allowance, and that there are no remaining issues in the application. Allowance of the application as now presented, and passing of the application to issue are respectfully solicited.

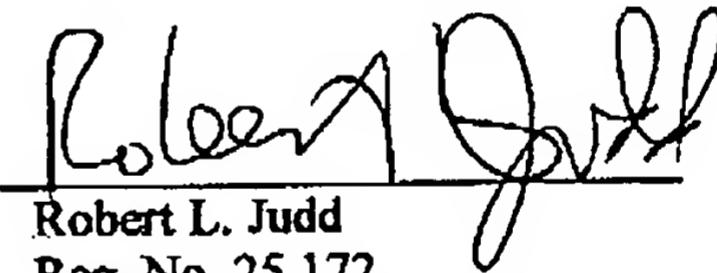
If for any reason the Examiner feels that this amendment does not so place the application in condition for allowance, it is respectfully requested that the Examiner promptly contact applicant's undersigned attorney by telephone at the number shown below so that suitable steps may be taken to place the application in such condition.

Further and favorable action is respectfully requested.

Respectfully submitted,

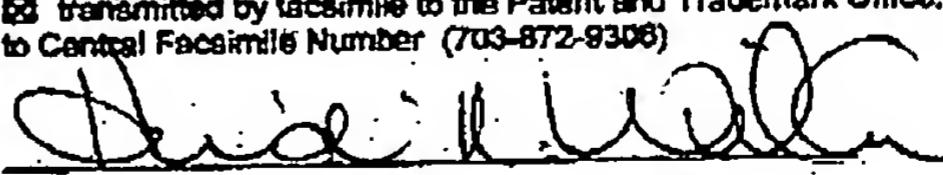
Taglia, Fette, Dumke & White, P.C.

By



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Dated: August 15, 2005

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